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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,924	09/30/2003	Kevin Murphy	P-6153-US	7370
49444 7590 09/12/2008 PEARL COHEN ZEDEK LATZER, LLP 1500 BROADWAY, 12TH FLOOR NEW YORK, NY 10036				
EXAMINER				
CHRISS, ANDREW W				
ART UNIT		PAPER NUMBER		
2619				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/673,924

Applicant(s)

MURPHY ET AL.

Examiner

Andrew Chriss

Art Unit

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-12 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-12 and 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment, filed February 21, 2008, has been entered and carefully considered. Claims 3, 5, 13-15, and 27 are cancelled, Claims 1, 4, 9, 10, 22, and 25 are amended, and Claims 1, 2, 4, 6-12, and 16-26 are currently pending.
2. In light of Applicant's amendment, rejection of Claims 1-4, 8-14, 18-21, and 25 under 35 U.S.C. 102(e) and Claims 5-7, 15-17, 22-24, 26 and 27 under 35 U.S.C. 103(a) is withdrawn.

Specification

3. The disclosure is objected to because of the following informalities: In paragraph 0033, line 8, the term "than" should be changed to "then."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 10-12 and 16-21** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Independent claim 10 recites an apparatus comprising a processor that performs steps of determining a size of a data item, determining a data transfer window size, and changing a payload header suppression rule. However, Applicant's specification does not provide support for an apparatus that solely contains a processor capable

of performing the invention by itself. A processor is known in the art to accept a program *as an input*, prepare it for execution, and execute the process so defined with data to produce results (emphasis added) (see *IEEE 100: The Authoritative Dictionary of IEEE Standard Terms*).

Therefore, a processor alone cannot act on its own to enable the claimed functionalities. The apparatus recited in Claim 10 is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 11, 12, and 16-21 depend on Claim 10 and fail to resolve the deficiencies therein.

6. **Claims 10-12 and 16-21** rejected under 35 U.S.C. 112, first paragraph, as comprising undue breadth. The claim language in Claim 10 recites “an apparatus comprising: a processor” and therefore constitutes a single means. Per MPEP 2164.08(a): “A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.” Claims 11, 12, and 16-21 depend on Claim 10 and fail to resolve the deficiencies therein.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 1, 2, 4, 6-12, and 16-26** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 1, the claim language cites “determining a size of a data item.” The claim language further cites “dynamically modifying a payload header suppression module if *a size of the data item is greater*” (emphasis added). It is unclear based on the claim language if the claimed data item has multiple sizes that could have been determined and whether the size that is initially determined is the same as the size used to dynamically modify a payload header suppression module. Independent claims 10, 22, and 25 comprise the same functional limitations described above. **Further regarding Claims 1, 11, 12, and 23**, it is unclear what a “payload header suppression module” refers to based on the specification. Claims 2, 4, 6-9, 11, 12, 16-21, 23, 24, and 26 depend on the independent claims cited above, and fail to resolve the deficiencies therein.

Regarding Claim 4, there is a lack of antecedent basis for claim language “the property of the data item.”

Regarding Claims 6, 16, and 24, it is unclear based on the claim language how the step of “suppressing a static portion of an acknowledgment packet” relates to the functional steps recited in Claims 1, 10, and 22.

Regarding Claims 7 and 17, it is unclear based on the claim language how the step of “restoring/rebuilding the suppressed portion of said acknowledgment packet” relates to the functional steps recited in Claims 1 and 10.

9. **Claims 22-24** rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: a relationship between the claimed “dynamic random access memory” and “processor.”

Response to Arguments

10. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new grounds of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Kye (United States Patent Application Publication US 2002/0067721 A1) discloses a cable modem and cable modem terminal system capable of modifying payload header suppression rules using dynamic service change messages.
- b. Le et al (United States Patent 6,882,637) discloses adjusting a header compression scheme to save bandwidth.
- c. Bunn et al (United States Patent Application Publication US 2002/0073227 A1) discloses cable modem header suppression.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW CHRISS whose telephone number is (571)272-1774. The examiner can normally be reached on Monday-Friday, 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrew Chriss
Examiner
Art Unit 2619
9/2/2008

/Hassan Kizou/

Supervisory Patent Examiner, Art Unit 2619